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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,902	06/13/2001	Y Tom Tang	PF-0577 USN	3561

7590 08/07/2003

Legal Department  
Incyte Genomics  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER
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MAYES, LAURIE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/07/2003

(3)

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/763,902	TANG ET AL.	
	Examiner Laurie Mayes	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 April 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above claim(s) 21,25,27,32 and 33 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 22-24,26 and 28-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group II in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the nucleotides of Group II encode the polypeptides of Group I and that including the antibodies of Group III would involve a similar search. This is not found persuasive because the polypeptides, polynucleotides and antibodies all have different structures and functions and a search of one or the other is not coextensive. A search of proteins does not necessarily result in a search of polynucleotides nor of, e.g., antibodies. The polypeptide may be used in an assay or to treat disease, the polynucleotide may be used to encode a protein and the antibodies respond to antigens and have immunogenic functions. The protein is classified in class 530, 350 and requires a search of over 7,500 US patents in a patent database, the nucleic acid molecule alone is classified in class 536, subclass 23.1 require a search of over 7,500 different patents and the antibody classified in class 530, subclass 387.1 requires a search of an additional 1,000 different patents. Further, the invention in claim 1 is known in the art. Kain et al. (cited in paper #11) teach a polypeptide that has 98.5% sequence identity to SEQ ID NO: 1 of claim 1. Thus a polypeptide with at least 90% identity to SEQ ID NO: 1 is known in the art and these groups of invention lack a common novel step and unity of invention.

In view of the applicant's arguments on pages 7-11 that SEQ ID NOS: 9-16 listed in claim 28 are structurally and functionally similar and are part of a Markush group, these sequence will be searched together.

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The requirement is still deemed proper and is therefore made FINAL. Claims 22-24, 26 and 28-31 are examined and claims 21, 25, 27, 32 and 33 are withdrawn as being drawn to a non-elected invention.

*Specification*

The use of trademarks (TAQ, p. 16, line 32; PELTIER THERMAL CYCLER, p. 17, line 3, for example) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 22 and 26 recite the limitation "claim 21". However, claim 21 has been withdrawn as directed to a non-elected invention and therefore there is insufficient antecedent basis for this limitation in the claim as to the language "claim 21".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 22-24, 26 and 28-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Kain et al. (J. Biol. Chem. V273, N.2, 981-988 (Jan. 1998)). Kain et al. teaches an isolated nucleic acid encoding a protein with 98.5% sequence identity to the protein (SEQ ID NO: 1 of the present invention, which is encoded by nucleic acid sequence ID NO: 9 of the present invention). Absent factual evidence to the contrary, the polynucleotide encoding this protein has over 90% sequence identity to SEQ ID NO: 9 (present claims 22 and 28). Kain et al. also teach a method of producing a polypeptide comprising culturing a cell under conditions suitable for expression of the polypeptide (see “experimental procedures”, p. 982-984)(present claim 26) wherein said cell is transformed with a recombinant polynucleotide and said recombinant polynucleotide comprises a promoter sequence (present claim 23) operably linked to a polynucleotide encoding the polypeptide wherein a cell is transformed with the recombinant polynucleotide (p. 982, col. 2 and p. 983, col. 1)(present claim 24) and recovering the expressed polypeptide (present claim 26). Kain et al. also teach a method of detecting a target polynucleotide (present claim 29) in a sample comprising amplifying the target polynucleotide using polymerase chain reaction amplification (p. 983, col. 1, last para. and col. 2+)(present claim 31), hybridizing the sample (col. 7, lines 1-30) with a probe comprising at least 60

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contiguous nucleotides (p. 983, col. 2, 2<sup>nd</sup> para.)(present claim 30) which hybridizes to the target polynucleotide under conditions whereby a hybridization complex is formed and detecting the presence or absence of said hybridization complex. Kain et al. teaches all of the elements of claims 22-24, 26 and 28-31 and these claims are anticipated under 35 U.S.C. 102(a).

***Conclusion***

**Claims 22-24, 26 and 28-31 are rejected. No claims are allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.

*L. Mayes*  
Laurie Mayes  
Patent Examiner  
Art Unit 1653  
August 6, 2003

*Christopher S. Low*  
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SUPERVISORY PATENT EXAMINER  
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